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BRIAN ROFFE, ESQ 11 SUNRISE PLAZA, SUITE 303 VALLEY STREAM, NY 11580-6111			EXAMINER LEVINE, ADAM L	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/014,720

Applicant(s)

SHAER, ARI

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 and 18 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)                     | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Please refer to the interview summary record form PTOL-413, paper #060328, mailed March 31, 2006, for additional guidance.

#### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 8-12, and 21, drawn to methods for enabling an event organizer to plan an event while collecting additional sums charged for items and services by the system over and above a first price, classified in class 705, subclass 26.
  - II. Claims 13-20, drawn to methods for creating and selecting templates of packages of several goods and/or services for use at an event, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as creating and selecting templates of packages of goods and/or services for use at an

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event. See MPEP § 806.05(d). Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

During an applicant initiated telephonic interview attended by Robert Pond (Primary Examiner), Brian Roffe (Reg. No. 35,336) Ari Shaer, and the present examiner on March 31, 2006, a provisional election was made without traverse to prosecute the invention of group I, claims 1-6, 8-12, and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings were received on April 23, 2002, and replacement drawing figures 1I, 1J, 1K, 25, 27, and 29 were received on July 18, 2005. Objections noted in the prior office action have been overcome. These drawings are now objected to for the reasons indicated in the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The substitute Specification has been entered. Examiner appreciates Applicant's efforts in correcting the previously noted informalities and in improving the Summary to provide a concise description.

Regarding the substitute Specification, the disclosure is objected to because of the following informalities: The amendment filed July 18, 2005, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The "Information Template" on page 8 lines 2-13 of the summary is given special meaning and described in significantly more detail in the amended disclosure than is present in the original. As a result, substantive new meaning is now attributable to the term and it has been changed into an especially significant feature of the invention where it previously was noted only briefly and tangentially. Applicant is required to cancel the new matter in the reply to this Office Action. Examiner notes that this may be an inadvertent substitution of the term "Information Template" instead of the term "knowledge template" that is more extensively used in both the original and substitute specifications. If this is an accurate observation then the disclosure should be amended to make clear that the terms are synonymous.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1,6,9-10, 12, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 1, the phrase "suggested retail price" renders the claim indefinite because it is unclear whether the retail price is the actual price to be charged the gift givers. See MPEP § 2173.05(d). This is being interpreted as the price charged.

Claim 6 is rejected because it is unclear at what price the organizer is enabled to purchase the gift, how that price is determined, whether it is determined or even whether it is determinable.

Regarding claims 9-10, the phrase "others" renders the claim indefinite because it is unclear to whom "others" refers. Are these other event organizers? This would seem the logical interpretation since the event organizer is the only party previously identified in the claim. In context of the invention, however, the examiner understands the term as intended to refer to gift givers or consumers other than the organizer. See MPEP § 2173.05(d).

The term "similar" in claim 12 is a relative term that renders the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant's attempt to resolve the prior indefiniteness through amendment to delete the word "substantially" from "substantially similar" is noted and is appreciated, however, this alone does not resolve the indefiniteness. The absence of remarks in support of removing the rejection on the basis of this amendment leaves no other alternative than to maintain the rejection.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "feedback loop" in claim 21 is used by the claim to mean "payment for goods and services using the benefit to the event organizer obtained from previous purchases", while the redefined meaning in the specification is "an action that exerts control over a previous action." The term is indefinite because the specification does not clearly redefine the term. Because claim 21 is generally narrative and indefinite, failing to conform with current U.S. practice, it is also rejected as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**2. Claims 1-2,6, 8-9,12, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Bezos (US Patent No. 6,029,141).**

Bezos teaches all the limitations of claims 1-2,6,8-9,12, and 21. For example, Bezos discloses allowing an organizer to set up an online database of gifts and services in conjunction with an event, allowing a user to purchase the gifts and services and providing a benefit to the organizer based on the difference between the purchase price and the price paid to acquire the items for resale to the user (see at least abstract. Please note: The desirability of the goods, and the event, are descriptive material and are not functionally involved in the recited steps of the method. Because they have no functional role in the method they are non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. It is the examiner's position that the desirability of the goods and services to the organizer, and the event context, are not distinguishing because there is nothing to preclude an organizer from using the invention of Bezos in the exact same way, for the same purposes, and in the same context as the present application and it

would be indistinguishable. The present claims fall squarely within the metes and bounds of the invention disclosed in Bezos.). Bezos further discloses:

- creating an on-line database of gifts and services: desired by the organizer, providing a website to enable creation of the database, displaying options of different gifts and services to the organizer at the website, and displaying advertising of providers of gifts and services at the website, with an associated cost (see at least abstract, figs.2-4, column 3 lines 8-25, column 8 lines 32-59, column 11 lines 16-26. Please note: The desirability of the goods is descriptive and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. It is the examiner's position that the desirability of the goods and services to the organizer is not distinguishing because it has no effect on the practice of the method.); displaying different categories of gifts and services to the organizer, enabling the selection of each of the categories of gifts and services, for each category, displaying different gifts or services and enabling the selection of each of the gifts and services, whereby the organizer is able to select either categories of gift and services for entry into the database, specific gifts and services within each category for entry into the database or a combination thereof (see at least abstract, figs.2-4, column 3 lines 8-25, column 8 lines 32-59, column 11 lines 16-26); embodying the database in

computer-readable media (see at least abstract, figs.1-2,5; column 1 line 62 – column 2 line 38).

- obtaining a first price for the gifts and services in the database: (see at least column 7 lines 40-60, column 14 lines 38-51); obtaining a price from several gift and service providers for each gift and service, further comprising enabling access to said database by the organizer, displaying the gifts and services and the prices provided by the gift and service providers, and enabling the organizer to purchase the gift and services from any of the gift and service providers that submitted a price for the gift and services (see at least figs.8-10, column 7 lines 40-60, column 12 lines 14-26, column 14 lines 38-51, column 15 lines 61-67.

Please note: the organizer is enabled to purchase gifts and services by merely using the system and method itself as a purchaser).

- enabling access by gift givers to the database: (see at least column 1 lines 16-36, column 4 lines 58-64, column 6 line 59-column 7 line 5, column 11 lines 27-42).
- displaying to the gift givers the gifts and services in the database: and a second price for the gift and services and enabling the gift givers to select one or more of the gifts and services for purchase on behalf of the organizer, the second price being a suggested retail price greater than the first price (see at least figs.8-10, column 7 lines 52-60, column 12 lines 14-26, column 15 lines 61-67); enabling others to access the database and commit to payment for the desired goods and services, associating the manner of payment with the desired goods and

services, and upon acceptance by a provider of the goods and services to the manner of payment associated with the goods and services, contractually obligating the provider of the goods and services to deliver the goods and services for the event (see at least abstract, figs.10, column 1 line 62 – column 2 line 18, column 2 line 48 – column 3 line 7, column 6 lines 41-47).

- upon receipt of funds from the gift givers equal to the second price: directing one of the gift and service providers to forward the gift to the organizer or perform the services for the organizer (see at least figs.10, column 3 lines 8-25, column 6 lines 12-20,41-47; column 15 lines 28-50. Please note: the invention discloses directing delivery by providing information. In the present case the information would be the organizer's address).
- determining a difference between the first and second prices: upon receipt of funds from the gift giver equal to the second price, directing at least part of the difference in price to an account of the organizer, generating benefit for the event organizer based on the contractual obligation (see at least fig.3a, column 1 line 62 – column 2 line 18, column 7 lines 41-51, column 13 lines 1-8, column 18 lines 30-65); contractual obligation of the provider of the goods and services to deliver the goods and services for the event is established prior to the event such that the benefit for the event organizer based on the contractual obligation is generated prior to the event and thus the event organizer is enabled to use the benefit to obtain goods and services prior to the event thereby creating a feedback loop from payment for goods and services to potential use of a benefit

generated from such payment to purchase additional goods and services in the database (see at least see at least fig.3a, column 1 line 62 – column 2 line 18, column 7 lines 41-51, column 13 lines 1-8, column 18 lines 30-65. Please note: a purchase by the organizer using credit from a previous purchase could still be applied to goods or services purchased later, though still prior to the event, for use at the same event).

- enabling the organizer to use the at least part of the difference: in price to purchase gifts and services in the database prior to the event, enabling the event organizer to use the benefit to obtain goods and services for use at the event (Please note: the organizer is enabled to use the at least part of the difference in price to purchase gifts and services by merely using the system and method itself as a purchaser).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 3-5 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent No. 6,029,141) in view of Robertson (Paper #20050204, US Patent No. 6,609,106).**

Bezos teaches all of the above as noted under the 102(a) rejection and teaches a) an organizer setting up a website with items chosen by the organizer, b) organizers marketing products on behalf of merchants, c) organizers compensated for sales through their websites, and d) compensation to organizers based on items sold through the organizer's website. Bezos however does not disclose:

- contacting gift and service providers to solicit bids: from the gift and service providers, soliciting providers of goods and services to commit to provide the goods and services at the associated cost, enlisting providers of gifts and services to submit bids for gifts and services listed in said database, and electronically notifying the providers when one of the gifts and services provided by the gift and service provider is included in the database; conducting an auction among possible providers to obtain a lowest price for the gifts and services; determining whether a good or service desired for the event is the same or similar to a good or service desired for another event as contained in a database for the other event, and if so, notifying potential providers of the good or services of the presence of multiple requests for the same or similar good or service; and
- determining specific events or parties in a specified: geographical location, within a specified range.

Robertson teaches a) an organizer setting up a website with items chosen by the organizer, b) organizers marketing products on behalf of merchants, c) organizers

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compensated for sales through their websites, and d) compensation to organizers based on items sold through the organizer's website, and Robertson also teaches:

- contacting gift and service providers to solicit bids: from the gift and service providers, soliciting providers of goods and services to commit to provide the goods and services at the associated cost (see at least column 13 lines 5-18, 23-27; column 15 lines 19-31), enlisting providers of gifts and services to submit bids for gifts and services listed in said database, and electronically notifying the providers when one of the gifts and services provided by the gift and service provider is included in the database (see at least column 3 lines 47-54, where providers register items for sale and are notified upon the occurrence of certain events, and column 9 lines 25-37. Please note: Such events could be the inclusion of the providers' gift or service in the database. Regardless, such notification is inherent); conducting an auction among possible providers to obtain a lowest price for the gifts and services (see at least column 15 lines 19-31, and column 19 lines 19-33); determining whether a good or service desired for the event is the same or similar to a good or service desired for another event as contained in a database for the other event, and if so, notifying potential providers of the good or services of the presence of multiple requests for the same or similar good or service (see at least column 13 lines 5-15, column 16 lines 50-59).

- determining specific events or parties in a specified: geographical location, within a specified range (see at least Figs. 8,40,41; column 9 lines 33-37, column 21 lines 37-55, column 24 lines 54-65, column 25 lines 5-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Bezos to include contacting gift and service providers to solicit bids from the gift and service providers, soliciting them to commit to provide goods and services at the associated cost, electronically notifying them when one of the gifts and services they provide is included in the database, conducting an auction among them to obtain a lowest price for the gifts and services, determine whether a good or service desired for the event is the same or similar to a good or service desired for another event as contained in a database for the other event, and if so notifying them, and determining specific events or parties in a specified geographical location within a specified range, as taught by Robertson, in order to facilitate the completion of the commercial cycle to enable Bezos to function as intended, thereby increasing commerce and profits using the system.

### ***Conclusion***

As noted in the interview summary record form PTOL-413, paper #060328, mailed March 31, 2006, the present office action is based upon the clarified relationship between the first and second price discussed in the interview in light of the specification. It is noted that the prior art previously relied upon is still applicable to the current claims of record. As such, this action is necessarily based on a hypothetical understanding of

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anticipated claim amendments. It is hoped that the new grounds of rejection will provide additional aid to the applicant in refining the claims, however in doing so the applicant is advised to remain aware of the applicability of the previously cited art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Togher; US Patent No. 5,375,055 A (Dec. 1994): Teaches soliciting bids and offers from counterparties in a trading system, enabling a party to purchase an item at a lower price and sell it at a higher price, allowing an arbitrage opportunity wherein the difference is credited to an organizer.
- Abel; US Patent No. 5,852,809 (Dec. 1998): Teaches crediting organizers with a flat fee referral payment for each purchase made by another subscriber sent by the organizer.

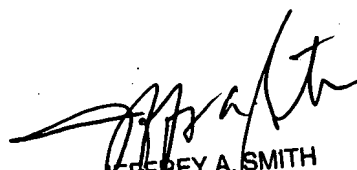
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
October 23, 2007



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